

REMARKS

At the outset, applicants would like to thank Examiner Lilling for his time and consideration of the present application during the brief telephonic interview with the undersigned attorney on January 25, 2005. During the interview, the issues raised in the outstanding Official Action were discussed.

Claims 1-10 are pending in the present application. Claims 1-10 have been amended to address the issues raised in the outstanding Official Action. Support for the changes to claims 1-10 may be found in the original claims and generally through the present specification.

In the outstanding Official Action, claims 8-10 were withdrawn from consideration for allegedly being directed to a non-elected invention. At this time, Applicants respectfully request that claims 8-10 be rejoined with claims 1-7. Original claims 8 and 9 were directed to the use of an orthoester. However, as the Examiner is aware "use" claims are not permitted under United States patent practice and pursued as method claims. Thus, in the amendment of October 18, 2004, claims 8 and 9 were rewritten as method claims. As claims 8 and 9 were originally "use" claims and "use" claims are pursued as method claims under United States patent practice, Applicants believe that claims 8 and 9 are directed to the same invention as claims 1-7. Indeed, applicants do not believe that claims 8 and 9 represent a non-elected invention.

As to claim 10, applicants believe that claim 10 is directed to a process for the resolution of an enantiomeric mixture of chiral carboxylic acid of formula R-COOH. Thus, claim 10 is directed to the same subject matter as claims 1-7. As a result, applicants do not believe that claim 10 represents a non-elected invention.

Thus, in view of the above, applicants respectfully request the rejoinder of claims 8-10.

Claims 1-7 were rejected under 35 USC §112, first paragraph, for allegedly not satisfying the written description requirement. This rejection is respectfully traversed.

In imposing the rejection, the Official Action alleged that the present disclosure did not support the phrase "to determine the resolution of said enantiomeric mixture". While applicants believe that the statement is implicitly supported by the present disclosure, in the interest of advancing prosecution, claims 1-7 have been amended so that this phrase is no longer recited. Indeed, as discussed in the interview, claim 1 has been amended to delete the phrase "to determine the resolution". Thus, in view of the above, applicants believe that the present amendment obviates this rejection.

In view of the present amendment and the foregoing remarks, therefore, applicants believe that the present application is in condition for allowance at the time of the next

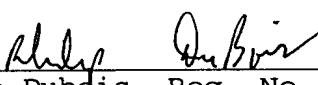
Docket No. 2503-1003
Reply to Office Action of November 5, 2004
Appln. No. 10/048,120

Official Action, with claims 1-10, as presented. Allowance and passage to issue on that basis are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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PD/mjr
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